

Practitioner's Docket No. 1001.117

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Wieber

Application No.: 10/606,602

Group No.: 3612

Filed: 06/26/2003

Examiner: K. Patel

For: ATTACHMENT SYSTEM AND METHOD OF FORMING SAME

Mail Stop Appeal Briefs – Patents

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TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION--37 C.F.R. § 1.192)

1. Transmitted herewith, in triplicate, is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on December 15, 2004.
2. STATUS OF APPLICANT

This application is on behalf of other than a small entity.

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*
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Date: 2/11/05

Allan Leshchinsky
(type or print name of person certifying)

* Only the date of filing (' 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under ' 1.8 continues to be taken into account in determining timeliness. See ' 1.703(f). Consider "Express Mail Post Office to Addressee" (' 1.10) or facsimile transmission (' 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. § 1.17(c), the fee for filing the Appeal Brief is:

other than a small entity \$500.00

Appeal Brief fee due \$500.00

4. EXTENSION OF TERM

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE

The total fee due is:

Appeal brief fee \$500.00
Extension fee (if any) \$0.00

TOTAL FEE DUE \$500.00

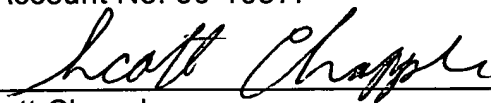
6. FEE PAYMENT

Attached is a check in the amount of \$500.00.

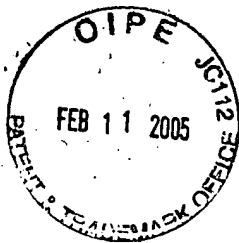
7. FEE DEFICIENCY

If any additional extension and/or fee is required, and if any additional fee for claims is required, charge Deposit Account No. 50-1097.

Date: 11 February 2005



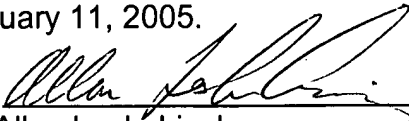
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Docket No. 1001-117

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BY: 
Allan Leshchinsky

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Wieber

Group Art Unit: 3612

Serial No. 10/606,602

Examiner: K. Patel

Filed: 6/26/2003

For: ATTACHMENT SYSTEM AND METHOD OF FORMING SAME

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313

APPEAL BRIEF UNDER 37 C.F.R. § 1.192 (Filed in Triplicate)

Sir:

This is an Appeal Brief under 37 C.F.R. § 1.192 appealing the Final

Rejection or Withdrawal of claims in the above-referenced patent application,

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which were rejected or withdrawn in an Office Action dated September 9, 2004¹. Each of the topics required by 37 C.F.R. § 1.192 is presented in this Brief and is labeled appropriately.

I. Real party in interest

L & L Products, Inc., (a Michigan Corporation) of Romeo, Michigan ("L&L") is the real party in interest of the present application. An assignment of all rights in the present application to L&L was executed by the inventor and recorded by the U.S. Patent and Trademark Office.

II. Related appeals and interferences

There are no appeals or interferences related to the present application of which the Appellant is aware.

III. Status of claims

Claim 1 stands finally rejected and claims 3, 6, 8, 9, 13 and 22-38 stand as withdrawn from consideration by the Office Action of September 9, 2005. Appellant hereby appeals the final rejection of claim 1 and the withdrawal of claims 3, 6, 8, 9, 13 and 22-38 from consideration. Appellant respectfully

¹ Appellant has phoned both the Examiner for the present application and the Examiner's Supervisor to resolve the issues of the application without Appeal, particularly the issues related to the withdrawal of claims from consideration. However, Appellant has had no success addressing these issues in this manner and therefore files this Appeal.

request an indication of allowability of claim 1 or at least a reversal of the rejection of claim 1. Appellant further requests that the withdrawal of claims 3, 6, 8, 9, 13 and 22-38 be reversed.

IV. Status of amendments

A First Office Action was issued on May 11, 2004 rejecting claims 1, 3, 6, 8, 9 and 13. filed a Response and Amendment on July 21, 2004 addressing the First Office Action. The Response and Amendment did not amend claims 1, 3, 6, 8, 9 and 13, but it added claims 22-38. A Final Office Action was issued September 9, 2004 rejecting claim 1 and withdrawing all remaining claims from consideration. submitted a Response and Request for Reconsideration Prior to Appeal dated November 3, 2004 and an Advisory Action was issued on November 26, 2004.

V. Summary of invention

The present invention generally relates to an attachment system that is particularly suitable for use in articles of manufacture such as automotive vehicles. Typically, the system includes the use of an adhesive material to join members such as vehicle body panels together. The adhesive material is preferably a thermosettable material that can be activated to foam, cure or the like by elevated temperatures.

VI. References of record

In the First Office Action of May 11, 2004 and in the Final Office Action of September 9, 2004, the Examiner relied upon the following prior art reference:

- (1) U.S. Patent 6,679,540 to Graber et al. (hereinafter referred to as Graber et al.).

VII. Issues

As stated above, Appellant is seeking a reversal of the withdrawal of claims 3, 6, 8, 9, 13 and 22-38 and an indication of allowability of claim 1 or at least a reversal of the obviousness rejection of claim 1.

For making these reversals and/or indications, the following issues should be addressed:

- 1) Were claims 3, 6, 8, 9 and 13 improperly withdrawn from consideration in the Final Office Action as being non-elected, particularly where the First Office Action treated these claims as being part of the elected group of claims and s did not amend any of these claims?
- 2) Has the examiner failed to establish a prima facie case of obviousness against claim 1 since at least one element of claim 1 has not been shown to be in the prior art and since no motivation has been provided for employing the aforementioned element together with the other elements of claim 1 as recited in claim 1?

- 3) Does the fact that the MPEP specifically contemplates that searching be done based upon the addition of new claim limitations in response to a First Office Action render the withdrawal of claims 22-24 and 27-38 improper since the only reason provided for withdrawal of the claims is that they include limitations that were not searched for a First Office Action?
- 4) Is withdrawal of claims 25-26 and 28-29 as being drawn to a non-elected species improper where no species election excluding the language of those claims has ever been made?

VIII. Grouping of claims

For purposes of the issues presented by this appeal, Appellant notes that a notice of allowance or a reversal of the obviousness rejection of claim 1 is requested. For the remaining claims, a reversal of improper withdrawal from consideration is requested.

IX. Arguments

Summary of Arguments:

Appellant request that the withdrawal of claims 3, 6, 8, 9, 13 and 22-38 and the rejection of claim 1 be reversed on the following grounds: I) Withdrawal of claims 3, 6, 8, 9 and 13 as being drawn to a non-elected species in a Second Office Action is improper, particularly where those claims were treated as part of

an elected species in the first Office Action; II) The rejection of Claim 1 asserted by the Final Office Action under 35 U.S.C. § 103 is legally inadequate to establish a prima facie case of obviousness since at least one element of claim 1 has not been shown to be in the prior art and no motivation has been provided to combine that element with the other elements of claim 1; III) Inclusion of limitations that were not searched for a First Office Action is a legally improper reason for withdrawal of claims 22-24 and 27-38 in a Second Office Action; IV) Withdrawal of claims 25-26 and 28-29 as being drawn to a non-elected species is improper where no species election excluding the language of those claims has ever been made.

Argument

A. Withdrawal of claims 3, 6, 8, 9 and 13 by the Second Office Action is improper, particularly where those claims were treated as part of an elected species in the first Office Action.

The second or Final Office Action of September 9, 2004 withdrew claims 3, 6, 8, 9 and 13 from further consideration. As a reason for such withdrawal, the Final Office Action suggests that, "these claims are drawn to a nonelected Species E. Species E does not contain the limitation of a layer of primer and layer of paint."² Appellant contend that this withdrawal of claims is improper, particularly where claims 3, 6, 8, 9 and 13 were originally treated as part of the

² s assume that this quote is intended to suggest that the claims are drawn to a nonelected species rather than, as written, "a nonelected Species E", particularly since s elected Species E.

elected species in the First Office Action of May 11, 2004 and were not amended in Response to the First Office Action.

Reference to the First Office Action shows that claims 3, 6, 8, 9 and 13 were treated as part of the elected species since claims 3, 6, 8, 9 and 13 were rejected under both 35 U.S.C. 112 and under 35 U.S.C. 103. Reference to s' Amendment and Response to the First Office Action, filed July 7, 2004 shows that claims 3, 6, 8, 9 and 13 were not amended in Response to the First Office Action. Appellant contends, therefore, that the withdrawal of claims 3, 6, 8, 9 and 13 is procedurally improper as it affords Appellant no opportunity to address the withdrawal since prosecution is technically closed by issuance of the Final Office Action. More to the point, however, MPEP section 818.01 reads that, "Election becomes fixed when the claims in an application have received an action on their merits by the Office." Thus, the First Office Action fixed the election to include claims 3, 6, 8, 9 and 13 by addressing the merits of claims 3, 6, 8, 9 and 13 in that Action. Thus, subsequent withdrawal of those claims is improper, particularly in view of the fact that s did not amend the claims. Appellant respectfully requests that the withdrawal of claims 3, 6, 8, 9 and 13 in the Final Office Action be reversed.

B. The rejection of Claim 1 as being obvious is legally inadequate and should be reversed.

The First Office Action rejected claim 1 as being obvious in view of U.S. Patent 6,679,540 to Graber et al. (hereinafter referred to as Graber et al.). Appellants contend that this rejection is legally inadequate to establish prima facie obviousness.

The MPEP 2143.03 reads, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." In *re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, "All words in a claim must be considered in judging the patentability of that claim against the prior art." In *re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Furthermore, The Court of Appeals for the Federal Circuit, in the case of *In re Lee*, 61 USPQ2d 1430 (CAFC 2002), wrote:

("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.");...

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective

teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

In rejecting claims 1, the First Office Action admits, at page 4, that Graber et al., "does not disclose the structural adhesive material having a tensile strength of at least 12 MPa which is applied with a mini-applicator including an extruder and the adhesive is formed from a heat activatable material that expands at a temperature encountered during at least one the an automotive e-coat and an automotive painting operation." The office then goes on, however, to make the conclusory statement that all of the subject matter not disclosed by Graber et al. would have been obvious, "since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Appellant contends that the Office Action has not shown the elements of the rejected claim and that the aforementioned conclusory statement does not excuse the requirement that, "...all the claim limitations must be taught or suggested by the prior art." Ibid. Moreover, absolutely no motivation is provided for combining the aforementioned elements (i.e., the elements not shown by Graber et al.) with the Graber et al. reference to arrive at the subject matter of the rejected claims. As such, the Office Action does not establish a prima facie case of obviousness against claims 1 and the rejection of those claims should be withdrawn.

Appellant is mindful of the fact that an attempt to support the First Office Action rejection of claim 1 is made in the Final Office Action. In particular, the Final Office Action suggests that, " has clearly indicated on pages 2, 3, 6, 7-11 of the specification that there is a commercially available material(s) which can be used having a tensile strength of a least 12Mpa which is applied with a mini-applicator including an extruder and the adhesive is formed from a heat activatable material that expands at a temperature encountered during at least one of an automotive e-coat and automotive painting operation." Appellant contend that this argument is not probative on the issue of obviousness. Even if such an indication were made by the specification³, commercial availability is not the test of obviousness. Moreover, such an indication would not relieve the Examiner's duty to present a prima facie case of obviousness by showing the elements of the claim in the prior art and also showing motivation to combine those elements in the overall combination set out in claim 1 of the application. Appellant requests that the rejection of claim 1 be reversed.

C. Inclusion of limitations that were not searched for in preparation for writing a First Office Action is a legally improper reason for withdrawal of claims 22-24 and 27-38 in a Second Office Action.

The Final Office Action withdrew claims 22-24 and 27-38 suggesting that, "Newly submitted claims 22-24, 27-38 directed to an invention that is independent or distinct from the invention originally claimed [sic] for the following

³ s do not acquiesce in the indication suggested by the Office Action.

reasons: they include limitations which were not searched in before preparation of the first office action i.e. a roof panel; a side panel; etc.” Appellant contends that this is an improper reason for withdrawal of claims 22-24 and 27-38.

The mere inclusion of limitations not searched prior to a first office action is an improper reason for withdrawal of claims from a patent application in a second or final office action. The MPEP explicitly contemplates that additional searching be done after the first or non-final Office Action and in preparation of a second or final Office Action if s choose to amend a claim to include language not previously searched during preparation of the First Office Action. In support of this assertion, Appellant quotes section 904 of the MPEP titled, “How to Search”, which reads, “The first search should be such that the examiner need not ordinarily make a second search of the prior art, unless necessitated by amendment to the claims by the in the first reply...”

As this section suggests, the MPEP contemplates that an Examiner, in preparation of a second or final office action, will need to do additional searching due to amedments presented in a Response to a first office action. As such, it is legally improper to refuse to do a second search merely because new claims, “include limitations which were not searched in before preparation of the first Office Action i.e. a roof panel; a side panel; etc.” As such, Appellant requests that the withdrawal of claims 22-24 and 27-38 on the grounds that, “they include limitations which were not searched in before preparation of the first office action” be reversed.

In addition, Appellant suggests that any attempt to suggest that these claims can be withdrawn on the basis of a combination/subcombination restriction lacks legal merit. In particular, a combination/subcombination restriction requires that the Patent Office show that a subcombination is claimed separately from a combination and that the subcombination have utility separate from the combination. In the present instance, however, certain of the claims and particularly claims 22-24 only further define elements already in claim 1. There is no set of elements that would properly represent the claiming a subcombination separate from the original combination of claim 1 in these claims. Moreover, where language is added to the claims (e.g., language related to welds, paint or the like), such language is either within any election of the present application or is improperly excluded from such election as further discussed below. Again, Appellant respectfully requests that the withdrawal of claims 22-24 and 27-38 be reversed.

D. Withdrawal of claims 25-26 and 28-29 as being drawn to a non-elected species is improper where no species election excluding the language of those claims has ever been made.

The Office Action suggests that, "claims 25-26 and 28-29 are withdrawn by the Examiner...as being drawn to a nonelected Species E. Species E does not contain the limitation of weld(s)."⁴ However, Appellant has never made an

⁴ s assume that this quote is intended to suggest that the claims are drawn to a nonelected species rather than, as written, "a nonelected Species E", particularly since s elected Species E.

election regarding welds. There is no mention of welds in the election/restriction requirement of March 31, 2004. is never requested to elect a species including or excluding welds. The actual application makes clear that the language discussing welds or the exclusion of welds can apply to each of the various embodiments of the invention shown in the drawings. As such, Appellant contends that the withdrawal of claims 25-26 and 28-29 is improper. Appellant respectfully requests that the withdrawal of claims 25-26 and 28-29 be reversed, particularly since Appellant was not afforded an opportunity to make an election regarding welds.

X. Conclusion

It is respectfully submitted that the Graber et al. reference does not render the subject matter of claim 1 obvious. It is further submitted that withdrawal of claims 3, 6, 8, 9, 13 and 22-38 was improper. Appellant respectfully requests an indication of allowability for claim 1 or at least a reversal of the obviousness rejection of claim 1. Appellant further requests a reversal of the withdrawal of claims 3, 6, 8, 9, 13 and 22-38 from consideration.

If for some reason Appellant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Respectfully submitted,

By 
Scott A. Chapple (Reg. No. 46,287)

Dated: February 11, 2005

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XI. APPENDIX

Claims on appeal

Claim 1: An attachment system for an article of manufacture, comprising:

a first member having a first flange providing a first attachment surface;

a second member having a second flange providing a second attachment surface, the second surface opposing the first surface, at least one of the first member and second member being a panel; and

a structural adhesive material adhered to the first surface and the second surface, the structural adhesive material having a tensile strength of at least 12 MPa.

Claim 3: An attachment system as in claim 1 wherein a layer of primer and a layer of paint are disposed directly over the adhesive material concealing the adhesive material from a surrounding environment and providing a Class A or a Class B finish.

Claim 6: An attachment system as in claim 3 wherein the structural adhesive material provides substantially the only attachment between the first surface and the second surface.

Claim 8: An attachment system as in claim 3 wherein the structural adhesive material is applied to at least one of the first surface and the second surface with a mini-applicator.

Claim 9: An attachment system as in claim 8 wherein the mini-applicator includes an extruder.

Claim 13: An attachment system as in claim 3 wherein the adhesive material is formed from a heat activatable material that expands at a temperature

encountered during at least one of an automotive e-coat and an automotive painting operation.

Claim 22: An attachment system as in claim 1 wherein the first member or the second member is a roof panel of an automotive vehicle.

Claim 23: An attachment system as in claim 22 wherein the first member or the second member is a side panel of an automotive vehicle.

Claim 24: An attachment system as in claim 1 wherein the first member or the second member is a side panel of an automotive vehicle.

Claim 25: An attachment system as in claim 1 wherein the first member is attached to the second member with less than 10 welds.

Claim 26: An attachment system as in claim 1 wherein the first member is attached to the second member with less than 5 welds.

Claim 27: An attachment system for an automotive vehicle, comprising:
a roof panel of the automotive vehicle, the roof panel having a flange extending at an angle from the roof panel, the flange providing an attachment surface;

a side body panel of the automotive vehicle, the side body panel having a flange extending at an angle from the side body panel, the flange of the side panel also providing an attachment surface; and

a structural adhesive material adhered to the attachment surface of the roof panel and the attachment surface of the side panel;

wherein the roof panel is attached to the side body panel with less than 20 welds; and

wherein a layer of primer, a layer of paint or both are disposed directly over the adhesive material.

Claim 28: An attachment system as in claim 27 wherein the roof panel is attached to the side panel with less than 10 welds.

Claim 29: An attachment system as in claim 27 wherein the roof panel is attached to the side panel with less than 5 welds.

Claim 30: An attachment system as in claim 27 wherein the structural adhesive material has a tensile strength of at least 12 MPa.

Claim 31: An attachment system as in claim 27 wherein the layer of primer, the layer of paint or both conceal the adhesive material from a surrounding environment and provide a Class A or a Class B finish.

Claim 32: An attachment system as in claim 27 wherein the structural adhesive material provides substantially the only attachment between the attachment surface of the flange of the roof panel and the attachment surface of the flange of the side panel.

Claim 33: An attachment system as in claim 27 wherein the structural adhesive material provides attachment between the roof panel and the body panel without the assistance of any welds.

Claim 34: An attachment system as in claim 27 wherein the adhesive material extends substantially continuously along the attachment surface of the roof panel.

Claim 35: An attachment system as in claim 27 wherein the adhesive material is formed from a heat activatable material that expands at a temperature encountered during at least one of an automotive e-coat and an automotive painting operation.

Claim 36: An attachment system as in claim 27 wherein the flange of the roof panel extends downwardly at an angle relative to the roof panel.

Claim 37: An attachment system as in claim 27 wherein the flange of the side body panel extends downwardly at an angle from the side body panel.

Claim 38: An attachment system for an automotive vehicle, comprising:
a roof panel of the automotive vehicle, the roof panel having a first flange extending at an angle from the roof panel, the first flange of the roof panel providing an attachment surface, the first flange of the roof panel extending downwardly at an angle relative to the roof panel;

a side body panel of the automotive vehicle, the side body panel having a first flange extending at an angle from the side body panel, the first flange of the side panel also providing an attachment surface, the first flange of the side panel extending downwardly, the body panel having a second flange extending from the first flange of the side panel; and

a structural adhesive material adhered to the attachment surface of the roof panel and the attachment surface of the side panel, the structural adhesive material being an epoxy-based structural foam, the structural adhesive material having a tensile strength of at least 12 MPa;

wherein the roof panel is attached to the side body panel with less than 10 welds;

wherein a layer of primer, a layer of paint or both are disposed directly over the adhesive material concealing the adhesive material from a surrounding environment and providing a Class A or a Class B finish;

wherein the adhesive material extends substantially continuously along the attachment surface of the first flange of the roof panel; and

wherein the adhesive material is formed from a heat activatable material that expands at a temperature encountered during at least one of an automotive e-coat and an automotive painting operation.